

Serial No.: 09/780,222
Amendment Dated May 27, 2005
Reply to Office Action of December 29, 2004

REMARKS

Claims 3, 4, 6, 8-14 and 24-38 are pending. Claims 3, 4, 6, 8-14 and 24-38 have been rejected. Claims 10-12, 24, 30, and 31 have been added.

DRAWINGS

The following revised drawings include the reference numbers "20" and "21".

Replace Figure 2a with the revised Figure 2a attached to this Amendment.

Replace Figure 3a with the revised Figure 3a attached to this Amendment.

Replace Figure 2b with the revised Figure 2b attached to this Amendment.

Replace Figure 3b with the revised Figure 3b attached to this Amendment.

Replace Figure 5 with the revised Figure 5 attached to this Amendment.

Replace Figure 6 with the revised Figure 6 attached to this Amendment.

Replace Figure 7 with the revised Figure 7 attached to this Amendment.

Rejection of Claims 3, 4, 6, 8-14, and 24-38 Under 35 U.S.C. §103.

The Examiner rejected Claims 3, 4, 6, 8-14, and 24-38 Under 35 U.S.C. §103 as being unpatentable over *Fischer* (6, 328,340) in view of *Matsuguchi et al* (EP-426,863).

Independent claims 10, 11, 12, 24, 30, and 31 have been amended herein to define the breakaway layer as "a single layer of dry release material" and having release levels in a predetermined pattern "at least within the periphery of the die cut". Support for these amendments can be found within the specification. On page 4, lines 8-15, the specification describes the breakaway layer has being "a dry release agent

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which both bonds to, and detaches from the primary film layer;...". FIGS. 1-6 illustrates the breakaway layer having a predetermined pattern within the periphery of the die cut.

The prior art references do not contain all the claim limitations of claims 10, 11, 12, 24, 30, and 31, as required by the Manual of Patent Examining Procedure ("MPEP") to establish a *prima facie* case of obviousness. The MPEP states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 706.02(j) (emphasis added). The MPEP also states,

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q.2d 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

MPEP § 2143.03 (emphasis added).

Neither *Fischer* nor *Matsuguchi* discloses a breakaway layer comprised of "a single layer of dry release material" and having release levels in a predetermined pattern "at least within the periphery of the die cut". Specifically in *Matsuguchi*, the examiner cites FIGS. 13A-14B as showing a breakaway layer having release levels that vary in a predetermined pattern. However, the breakaway layer in *Matsuguchi* is not present within the periphery of the die cut. Nor is there any suggestion or motivation,

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either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings such that they describe the invention of independent claims 10, 11, 12, 24, 30, and 31. *In re Jones*, 958 F.2d at 347. Therefore, it is submitted that claims 10, 11, 12, 24, 30, or 31 are patentable over Fischer, and hence, applicant respectfully requests that the rejection of claims 10, 11, 12, 24, 30, or 31 under 35 U.S.C. §103(a) be withdrawn.

It is noted that independent claim 10 forms the basis for each of dependent claims 3, 4, 6, 8, and 9. Independent claim 12 forms the basis for each of dependent claims 13 and 14. Independent claim 24 forms the basis for all dependent claims 25-29. Further, independent claim 31 forms the basis for dependent claims 32-38. Because a dependant claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from claims 10, 12, 24, and 31 must also be found nonobvious because the dependent claims depend from either independent claim 10, 11, 12, 24, 30, or 31, which claims are patentable over Fischer for the reasons described above.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 3, 4, 6, 8-14, and 24-38 as being obvious under 35 U.S.C. § 103(a).

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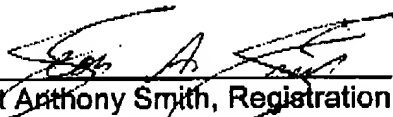
Conclusion.

Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's objections and all of the Examiner's rejections of claims 3, 4, 6, 8-14, and 24-38, and that claims 3, 4, 6, 8-14, and 24-38 are in condition for allowance. Therefore, it is suggested that claims 3, 4, 6, 8-14, and 24-38 constitute allowable subject matter and should be favorably considered by the Examiner, and it is requested that a timely Notice of Allowance be issued for those claims.

The Commissioner is heraby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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